

Practitioner's Docket No. 2471A/114

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Hisada et al.

Int'l Application No.: PCT/JP2004/015684

Group No.: Not yet assigned

Int'l Filing Date: October 22, 2004

Examiner: Not yet assigned

For: A METHOD FOR MANUFACTURING A SOLID PLATING MATERIAL AND THE  
SOLID PLATING MATERIAL MANUFACTURED BY THE METHOD

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

## INFORMATION DISCLOSURE STATEMENT

(Information Disclosure Statement--page 1 of 10)

---

CERTIFICATION UNDER 37 C.F.R. SECTIONS 1.8(a) and 1.10\**(When using Express Mail, the Express Mail label number is mandatory;  
Express Mail certification is optional.)*

I hereby certify that, on the date shown below, this correspondence is being:

## MAILING

☒ deposited with the United States Postal Service in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA  
22313-1450

37 C.F.R. SECTION 1.8(a)

37 C.F.R. SECTION 1.10\*

☒ as "Express Mail Post Office to Addressee"☐ with sufficient postage as first class mail.

Mailing Label No. EV 771906809 US

## TRANSMISSION

☐ transmitted by facsimile to the Patent and Trademark Office.

Signature

Date: May 11, 2006

Timothy M. Murphy

**\*WARNING:** Each paper or fee filed by "Express Mail" **must** have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. section 1.10(b).  
"Since the filing of correspondence under section 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

**NOTE:** *"An information disclosure statement shall be considered by the Office if filed by the applicant:*

*(1) Within three months of the filing date of a national application;*

*(2) Within three months of the date of entry of the national stage as set forth in section 1.491 in an international application; or*

*(3) Before the mailing date of a first Office action on the merits, whichever event occurs last." 37 C.F.R. section 1.97(b).*

**NOTE:** *"Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section." 37 C.F.R. section 1.56(a).*

*"Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:*

*(1) each inventor named in the application;*

*(2) each attorney or agent who prepares or prosecutes the application; and*

*(3) every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application." 37 C.F.R. section 1.56(c).*

**NOTE:** *The "duty as described in section 1.56 will be met so long as the information in question was cited by the Office or submitted to the Office in the manner prescribed by sections 1.97(b) - (d) and 1.98 before issuance of the patent." Notice of January 9, 1992, 1135 O.G. 13-25 at 17.*

**WARNING:** *"No information disclosure statement may be filed in a provisional application." 37 C.F.R. section 1.51(b).*

### **List of Sections Forming Part of This Information Disclosure Statement**

The following sections are being submitted for this Information Disclosure Statement:

*(check sections forming a part of this statement: discard unused sections and number pages consecutively)*

1. ☒ Preliminary Statements
2. ☒ Forms PTO/SB/08A and 08B (substitute for Form PTO-1449)
3. ☐ Statement as to Information Not Found in Patents or Publications
4. ☐ Identification of Prior Application in Which Listed Information Was Already Cited and for Which No Copies Are Submitted or Need Be Submitted
5. ☐ Cumulative Patents or Publications
6. ☒ Copies of Listed Information Items Accompanying This Statement
7. ☒ Concise Explanation of Non-English Language Listed Information Items
  - 7A. ☒ ISA Search Report
  - 7B. ☒ English Language Version of Japanese Patent Office Search Report
8. ☐ Translation(s) of Non-English Language Documents
9. ☒ Concise Explanation of English Language Listed Information Items (Optional)
10. ☒ Identification of Person(s) Making This Information Disclosure Statement

*(complete the following, if appropriate)*

Sections \_\_\_\_\_, respectively, have been continued on ADDED PAGE(S).

**NOTE :** *"Once the minimum requirements are met, the examiner has an obligation to consider the information." Notice of April 20, 1992 (1138 O.G. 37-41, 37).*

## **Section 1. Preliminary statements**

Applicants submit herewith patents, publications or other information, of which they are aware that they believe may be material to the examination of this application, and in respect of which, there may be a duty to disclose.

The filing of this information disclosure statement shall not be construed as a representation that a search has been made (37 C.F.R. section 1.97(g)), an admission that the information cited is, or is considered to be, material to patentability, or that no other material information exists.

The filing of this information disclosure statement shall not be construed as an admission against interest in any manner. Notice of January 9, 1992, 1135 O.G. 13-25, at 25.

## SECTION 2. FORMS PTO/SB/08A and 08B (formerly Form PTO-1449)

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Hisada et al. Attorney Docket: 2471A/114

Int'l Application No. PCT/JP2004/015684 Art Group Unit: Not yet assigned

Int'l Filing Date October 22, 2004 Examiner Name: Not yet assigned

Invention: A METHOD FOR MANUFACTURING A SOLID PLATING MATERIAL AND THE SOLID PLATING MATERIAL MANUFACTURED BY THE METHOD

LIST OF PATENTS AND PUBLICATIONS FOR  
APPLICANT'S INFORMATION DISCLOSURE STATEMENT

U.S. PATENT DOCUMENTS					
Examiner Initials	Reference Number	Document Number	Issue Date	Inventor	Class/Subclass
	AA	US	June 28, 1974	Grant	117/94

FOREIGN PATENT DOCUMENTS						
Examiner Initials	Reference Number	Country Code	Document Number	Publication Date	Patentee or Applicant	Class/Subclass
	AB	JP	59-118267	July 7, 1984	Showa Aluminum Corp.	B23K 1/12, C22C 1/08, C23C 17/00
	AC	JP	51-77536	July 5, 1976	Nippon Steel Corp.	C23C 17/00, C23C 1/00
	AD	JP	50-6162	Jan. 22, 1975	Union Carbide Corp.	91 C91, 91 C911
	AE	JP	8-257914	Oct. 8, 1996		B24C 11/00

OTHER DOCUMENTS			
Examiner Initials	Reference Number	Author	Title of Article, Title of Journal, Volume Number, Page Numbers, Date
	AF	Authorized Officer	International Search Report, ISA/Japanese Patent Office, February 22, 2005, 4 pages

Examiner Signature: \_\_\_\_\_

Date Considered: \_\_\_\_\_

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation *if not* in conformance and not considered. Include copy of this form with next communication to applicant.

## Section 6. Copies of Listed Information Items Accompanying This Statement

*NOTE: 37 C.F.R. section 1.98(a)(2) requires that any information disclosure statement filed under section 1.97 shall include: "A legible copy of: (1) Each U.S. and foreign patent; (ii) Each publication or that portion which caused it to be listed; and (iii) All other information or that portion which caused it to be listed, except that no copy of a U.S. patent application need be included . . ."*

*NOTE: The wording in section 1.98(a)(2)(iii) makes it clear that the requirement to submit a copy of each item of information listed in an information disclosure statement does not apply to the citation of a U.S. patent application. Notice of January 9, 1992, 1135 O.G. 13-25, at 14.*

Legible copies of all items listed in Forms PTO/SB/08A and 08B (substitute for Form PTO-1449) accompany this information statement.

☒ Exception(s) to above:

**U.S. patent citations are not included pursuant to the United State Patent and Trademarks Office's September 21, 2004 waiver of the copy requirement in 37 CFR 1.98 for cited pending U.S. patent citations when the patent citations are available in the USPTO's IFW system.**

☐ Items in prior application, from which an earlier filing date is claimed for this application, as identified in Section 4.

☐ Cumulative patents or publications identified in Section 5.

## **Section 7. Concise Explanation of Non-English Language List Information Items**

**NOTE:** *"A concise explanation of the relevance, as it is presently understood by the individual designated in section 1.56(c) most knowledgeable about the content of the information of each patent, publication, or other information listed that is not in the English language shall be included in any information disclosure statement filed under section 1.97. The concise explanation may be either separate from the specification or incorporated therein." 37 C.F.R. section 1.98(a)(3).*

**NOTE:** *"[T]he explanation required is limited to the relevance as understood by the individual designated in section 1.56(c) most knowledgeable about the content of the information at the time the information is submitted to the Office." Notice of January 9, 1992, 1135 O.G. 13-25 at 14.*

**NOTE:** *"Where the information listed is not in the English language, but was cited in a search report by a foreign patent officer, the requirement for a concise explanation of relevance is satisfied by submitting an English language version of the search report." Notice of January 9, 1992, 1135 O.G. 13-25. at 14.*

**NOTE:** *"The concise explanation requirement for non-English language information may be met by submission of an English language version of the search report indicating the degree of relevance found by the foreign office." Notice of January 9, 1992, 1135 O.G. 13-25, at 20.*

**WARNING:** *"The requirement in section 1.98(a)(3) for a concise explanation of non-English language information would not be satisfied by a statement that a reference was cited in the prosecution of a parent application." Notice of January 9, 1992, 1135 O.G. 13-25 at 20 (emphasis added).*

**Section 7A. Concise Explanation of Non-English Language Listed Information Items in ISA Search Report**

The relevance with respect to the following citations listed on Forms PTO/SB/08A and 08B (substitute for PTO-1449): **References AB through AE**

are submitted on the basis of the accompanying:

☐ EPO search report that is in the English language,

☒ International search report that is not in the English language and that is accompanied by an English language version of the Japanese Patent Office search report (**See Reference AF**), that issued on the corresponding Japanese patent application.

**Section 7B. Concise Explanation of Non-English Language Listed Information Items English Language Version of EPO Search Report**

**References AB through AE are Japanese patents listed in the attached International Search Report (Reference AF).**



## **Section 9. Concise Explanation of English Language Listed Information Items (OPTIONAL)**

*NOTE: "Applicants may, if they wish, provide a concise explanation of why English-language information is being submitted and how it is understood to be relevant. Concise explanations are helpful to the Office, particularly where documents are lengthy and complex and applicant is aware of a section that is highly relevant to patentability or where a large number of documents are submitted and applicant is aware that one or more are highly relevant to patentability." Notice of April 20, 1992 (1138 O.G. 37-47, 38).*

**Reference AA is referenced in the attached International Search Report (Reference AG) as part of the same family as Reference AD.**

**Section 10. Identification of Person(s) Making This Information Disclosure Statement**

The person making this certification is

*(check each applicable item)*

- (a) ☐ the inventor(s) who signs below

\_\_\_\_\_  
**SIGNATURE OF INVENTOR**

\_\_\_\_\_  
*(type name of inventor who is signing)*

- (b) ☐ an individual associated with the filing and prosecution of this application (37 C.F.R. section 1.56(c))

\_\_\_\_\_  
**SIGNATURE OF INVENTOR**

\_\_\_\_\_  
*(type name of inventor who is signing)*

- (c) ☒ the practitioner who signs below on the basis of the information:

*(check each applicable item)*

☐ supplied by the inventor(s).

☐ supplied by an individual associated with the filing and prosecution of this application. (37 C.F.R. section 1.56(c)).

☒ in the practitioner's file.

\_\_\_\_\_  


**SIGNATURE OF PRACTITIONER**

\_\_\_\_\_  
**Timothy M. Murphy**

\_\_\_\_\_  
*(type or print name of practitioner)*

\_\_\_\_\_  
**125 Summer Street, 11<sup>th</sup> Floor**

\_\_\_\_\_  
**P.O. Address**

\_\_\_\_\_  
**Boston, MA 02110-1618**

Reg. No.: 33,198

Tel. No.: (617) 443-9292

Customer No.: 002101

495829.1